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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,616	12/13/2001	Charles H. Lenore	DBH-0001	6587
23413	7590	05/04/2006	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 05/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/020,616	Applicant(s) LENORE ET AL.	
	Examiner Janice A. Mooneyham	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on February 21, 2006, wherein:

Claims 1-46 are currently pending;

Claims 1-2, 16-17, and 33-34 have been amended.

Response to Amendment

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 16-19, and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Krachman (US 6,738,760) in view of Simpson et al (US 6,549,894) (hereinafter referred to as Simpson).

Referring to Claims 1, 16, and 30-33:

Krachman discloses a method, system, and storage medium for managing legal information related to at least one legal matter in a system including a legal enterprise system and a remote system (Figures 2-3), the system comprising a storage system (24) (34) coupled via a network for communicating information (col. 4, lines 53-55). Figure 3 illustrates a network-based system; col. 4, lines 63-67 via the network 300), a database (24) (34), the method comprising:

storing legal information in a database associated with the storage system, said legal information including an evidentiary outline corresponding to the legal matter (Figures 1 and 7-13 Discovery), the evidentiary outline including a party's position and a link to evidence (Figure 1 (11) Deposition Transcripts etc.) stored in the database supporting the party's position (Figure 1 (11) Fact chronologies/issues); and providing the legal information to a user via the network (Figures 7-13; col. 4, lines 53-67).

While Krachman discloses a method and system for managing legal activity using artificial intelligence technology applied to computer databases and archives (col. 2, lines 11-18), Krachman does not explicitly disclose does not explicitly disclose that the link is created by a contributor having authority to modify legal information.

However, Simpson discloses a computerized docketing system for legal matters (col. 3, lines 36-47) wherein only authorized users are allowed access and wherein some users are given full read/write ability whereas others are given read only ability (col. 5, lines 36-48) and links to electronic intellectual property law forms programs (col. 5, lines 26-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the legal method and system of Krachman the ability to control access so that an administrator would have full read/write authority while others would be given read only authority for security purposes of allowing some users to browse screens without being able to make changes.

Referring to Claims 2, 17, and 34:

Simpson discloses determining if the user is a client having authority to view legal information in the database or the user has authority to modify legal information in the database (col. 5, lines 36-48 – For security purposes, only authorized users are allowed to access the docketing program. The System Setup screen (not shown) is used to set user security levels. For example, some users are given full read/write ability, whereas others are given read only ability. In a typical installation, a docketing administrator would be given full read/write authority, while responsible attorneys would be given read only authority. Thus, a docketing administrator could modify due dates and docket actions, but an attorney could only browse docket actions screens without being able to change any due dates, etc. The user verification screen shown in FIG. 2 is used to verify that a person attempting to use the program is authorized to do so).

Referring to Claims 3, 18, and 35:

Simpson discloses wherein the determining is based on a user identification and password (Figure 2 User Login and Password; The user verification screen shown in FIG. 2 is used to verify that a person attempting to use the program is authorized to do so).

Referring to Claims 4, 19, and 36:

Krachman discloses enabling a contributor to add further links to further evidence in the database (col. 3, lines 54-56 network can be linked to on-line legal services; col.

Art Unit: 3629

8, line 4-6 first generates index of potentially responsive documents, with coded, locked hyperlink to full text; col. 11, lines 40-58).

3. Claims 5-15, 20-28, and 37-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over claims Krachman and Simpson as applied to claim 1, 16, and 33 above, and further in view of Embracing the Virtual Office Concept: How Legal Anywhere Collaborator! Can Help, By David H. Griggs published February 2000 (hereinafter referred to as Griggs).

Referring to Claims 5-6, 20-21, and 37-38:

While Simpson discloses setting up different levels of access with some users given full read/write ability and others given read only (col. 5, lines 36-48), neither Krachman nor Simpson discloses enabling a user to edit a link to evidence in the database and restricting access to the legal information if the user is a client (page 2 Collaborator permits you to grant editing rights; page 2 you can collaborate with individuals outside of the firm – be they clients or outside co-counsel. Again, you can authorize or restrict access to anyone you wish and likewise limit access to certain areas for those who can access the site -Collaborator permits you to grant editing rights to other parties participating in the case/transaction (clients, co-counsel, colleagues)).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the legal methods and systems of Krachman and Simpson the ability to grant editing rights and authorize or restrict access to anyone you which

Art Unit: 3629

while limiting access to certain areas for those who can access the site so as to create a secure/private extranet for each client/law firm your are working with.

Referring to Claims 7-8, 22-23, and 39-40:

Griggs discloses wherein the contributor has access to legal information related to all of the plurality of legal matters and wherein the contributor has access related to a subset of all of the plurality of legal matters (page 2 you can collaborate with individuals outside of the firm – be they clients or outside co-counsel. Again, you can authorize or restrict access to anyone you wish and likewise limit access to certain areas for those who can access the site -Collaborator permits you to grant editing rights to other parties participating in the case/transaction (clients, co-counsel, colleagues).

Referring to Claims 9, 24, and 41:

Griggs discloses wherein the legal information is encrypted prior to transmission to the storage system (page 3 solutions is as secure as the current encryption levels allow).

Referring to Claims 10-14, 25-29, and 42-46:

Krachman discloses wherein the evidence includes documents produced during discovery, response to interrogatories, deposition transcripts, audio files, and video files (Figures 7-9 and col. 4, lines 20-26).

Referring to Claim 15:

Krachman discloses wherein the evidentiary outline includes parties' position (Figure 1 (11) Facts/Issues).

Response to Arguments

4. Applicant's arguments filed February 21, 2006 have been fully considered but they are not persuasive.

Applicant argues that Krachman does not teach that links are created in the database between a party's position and evidence supporting that position.

The Examiner respectfully disagrees with this assertion and directs the applicant to Figure 1 (11) wherein Krachman discloses case name, lawyers summary, pleadings, proof or fact, fact chronologies/issues, investigation reports, deposition transcripts etc.

Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e. Krachman does not teach that *links are created in the database between a party's position and evidence supporting that position*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims language reads, said legal information including an evidentiary outline corresponding to said legal matter, the evidentiary outline including a party's position and a link to evidence stored in the database supporting the party's position.

In addition, MPEP 2111 states that claims must be given their broadest reasonable interpretation consistent with the supporting description and that a claim must be interpreted in light of the specification without reading limitations into the claim.

The Merriam Webster Online dictionary found on Onelook.com defines link as:

Art Unit: 3629

link9 entries found for **link**.

To select an entry, click on it.

link{4,intransitive verb}		
chain-link fence		
cross-link		
cuff link		
missing link		
hot link		

Main Entry: **link** ☐

Pronunciation: 'li[ng]k

Function: *noun*Etymology: Middle English, of Scandinavian origin; akin to Old Norse *hlekk* chain; akin to Old English *hlanc* lank

1 : a connecting structure: as **a** (1) : a single ring or division of a chain (2) : one of the standardized divisions of a surveyor's chain that is 7.92 inches (20.1 centimeters) long and serves as a measure of length **b** : CUFF LINK **c** : BOND **3c d** : an intermediate rod or piece for transmitting force or motion; *especially* : a short connecting rod with a hole or pin at each end **e** : the fusible member of an electrical fuse **2** : something analogous to a link of chain: as **a** : a segment of sausage in a chain **b** : a connecting element or factor <found a *link* between smoking and cancer> **c** : a unit in a communication system **d** : an identifier attached to an element (as an index term) in a system in order to indicate or permit connection with other similarly identified elements

Thus, any identifier attached to an element (as an index term) in order to indicated connection would be a link. Therefore, the Examiner asserts that, under the

Art Unit: 3629

case name, the pleadings, proof of facts, and the investigation reports would be links to evidentiary evidence.

Applicant's arguments against Griggs were directed to the deficiencies of Krachman discussed above with reference to claim 1. This has been addressed in the response above.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

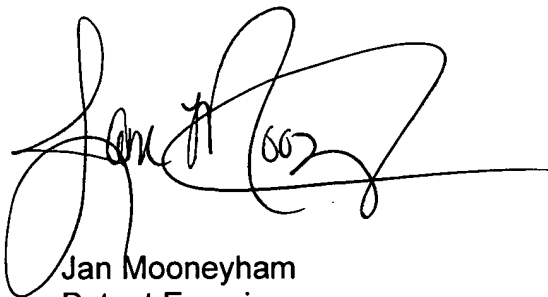
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3629

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Jan Mooneyham', with a large, stylized flourish extending to the right.

Jan Mooneyham
Patent Examiner
Art Unit 3629